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CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP
STEVEN M. GREENBERG
1300 CORPORATE CENTER WAY
SUITE 105G
WELLINGTON, FL 33414

EXAMINER

BLAIR, DOUGLAS B

ART UNIT

PAPER NUMBER

2142

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/017,728

Applicant(s)

AUERBACH ET AL.

Examiner

Douglas B. Blair

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Claims 8-14 are currently in pending in this application.
2. The applicant's amendments have obviated the previous rejections based on 35 USC 112 2nd paragraph.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 8-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,460,036 to Herz.

5. As to claim 8, Herz teaches a method for receiving publications and forwarding said publications on to parties who have subscribed to receive such publications, said method comprising:

receiving a subscription request of a first type, said request including a filter expression having at least one attribute (**col. 4, line 49-col. 5, line 7, the search profile or query contains keywords and target objects to request publications of interest**);

mapping at least a part of the at least one attribute to a generic format (**col. 57, lines 39-51, the search profiles are mapped to generic cluster profiles**);

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receiving a publication message of a second type (**col. 4, lines 49-col. 5, line 7, the target profile**);

comparing a publication message received the subscription request to determine whether the publication message is appropriate for forwarding onto a subscriber originating the request (**col. 57, lines 8-36, the search profile is compared with the target profile**), the step of comparing comprising:

identifying a generic format filter attribute (**cols. 57 and 58, the target profile**); mapping the generic format filter attribute to a format corresponding to the second message type (**col. 57, line 53-67, the target profiles are mapped to target profile cluster trees**), the method further comprising:

transmitting said publication message to the originating subscriber (**col. 58, lines 25-54, the list of articles is presented to the user.**).

6. As to claim 9, Herz teaches the communications manager of claim 8, further comprising preparing the publication message for transmission to said originating subscriber (**col. 58, lines 25-54, the list of articles are prepared for the user.**).

7. As to claim 10, Herz teaches the communications manager of claim 9, comprising: creating a substantially empty message of said first type (**the search profiles can contain few keywords or target objects**); extracting information from the publication message of said second type (**attributes are examined from the target profiles**); and inputting said information into said substantially empty message (**col. 56, line 49-col. 57, line 5**).

8. As to claim 11, Herz teaches the communications manager of claim 8, 9, or 10, wherein said mapping at least part of an attribute to a generic format comprises: invoking a first

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component capable of understanding messages of said first type (**the search profiles are analyzed as described above**).

9. As to claim 12, Herz teaches the communications manager claims 8, 9, or 10 comprising: storing said generic format filter attribute (**col. 56, line 49-col. 57, line 5**).

10. As to claim 13, Herz teaches the communications manager of any preceding claim, wherein said mapping a generic format filter attribute to a format corresponding to the second message type comprises: invoking a second component capable understanding messages of said second type (**the target profiles are analyzed as described above**).

11. As to claim 14, Herz teaches the communications manager of any preceding claim, wherein said format corresponding to the second message type is held in temporary storage until said comparison is complete (**col. 56, line 49-col. 57, line 5**).

Response to Arguments

12. Applicant's arguments filed 7/25/2006 have been fully considered but they are not persuasive. The applicant's main argument is that there is no apparent teaching within the cited section of Herz that a subscription request includes a first expression having at least one attribute and the examiner did not address the applicant's prior argument that the "Examiner is confusing 'specifying search parameters' with 'subscription requests'". In response the examiner points out that the Herz invention is directed towards providing information to subscribers so the search parameters provided by the user are considered subscription requests because the search parameters are used by the user to subscribe to various information sources. Merely stating that Herz does not teach a subscription request without elaborating on how the subscription request in

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the context of the applicant's invention is different from Herz does nothing to further prosecution because the examiner believes that Herz teaches a subscription request and would not have set the rejection forth otherwise.

13. The applicant further argues that the examiner has not clearly shown the rest of the claim limitations, however, the examiner feels that the rejection based on Herz clearly shows how Herz anticipates the claim language. If the applicant is still having trouble understanding the current rejections, the examiner invites the applicant to call the examiner so that the examiner can explain the rejections to the applicant. At that point the applicant can decide whether to make an amendment or how to argue that the limitations of the claims with respect to the applicant's invention are different from Herz.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas B. Blair whose telephone number is 571-272-3893. The examiner can normally be reached on 8:30am-5pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on 571-272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Douglas Blair

DBB



ANDREW CALDWELL

SENIOR PATENT EXAMINER